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EXAMINER
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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## DETAILED ACTION

### ***Response to Arguments***

1. Applicant's arguments, see remarks, filed 10 October 2008, with respect to the rejection of claims 21-22 under 35 U.S.C. 101 have been fully considered and are persuasive. Therefore the rejection of these claims has been withdrawn.
2. Applicant's arguments regarding the rejection of claims 1, 21, and 22 under 35 U.S.C. 112, second paragraph have been fully considered but they are not persuasive.
3. Applicant stated,

*In response to the above second source of alleged indefiniteness, the Applicant respectfully points out to the Examiner that independent claim 1 explicitly recites "requesting an address definition from a second device to a first device." Although the Examiner understood the above recitation to mean that the first device is requesting the address definition from the second device, it is the second device that is making the request for an address definition since the request is made from the second device. One of ordinary would understand the above ordinary meaning of the claim language in view of the specification at line 31 on page 7 through line 4 on page 8.*

4. The examiner respectfully disagrees. The claim does not state or imply that *the second device is making the request for an address definition*, in fact it states the opposite: requesting an address definition from a second device to a first device. Thus, one of ordinary skill in the art would reasonably interpret the limitations, as read in plain language as, *requesting (undefined as to which party is making the request) an address definition from a second device to a first device*. Furthermore, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).
5. Applicant also remarked,

As already provided in the previous response, the Applicant had argued that the two cited portions of the Taylor reference are not disclosing what the Examiner has characterized. That is, line 52, column 23 through line 18, column 24 of the Taylor reference fails to teach, disclose or suggest "a new address definition based upon the corresponding conditions at the second device" as explicitly recited by independent claim 1. By the same token, lines 19 through 40, column 24 of the Taylor reference fails to teach, disclose or suggest "the newly generated address definition including some components based upon the corresponding predetermined rule definition and corresponding conditions" as explicitly recited by independent claim 1. The Applicant respectfully request the Examiner to review the following arguments in view of the above two patentable distinctions.

6. Upon careful review of the cited prior art in regards to the pending claims, the examiner maintains the position that the applied art of record teach the invention as claimed. Since the remainder of applicant's remarks have been addressed in previous office actions, those responses are herein fully incorporated by reference, particularly, Final Rejection mailed on 01 November 2007, Non-Final Rejection mailed on 08 April 2008 and Final Rejection mailed on 19 August 2008.

#### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1, 21, and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claim 1 recites, **"requesting** an address definition **from a second device** to a first device." Then recites, **"returning** the address definition containing a plurality of

components to the second device **from the first device.**" If an address definition is requested from a second device, it should be returned from the second device not the first. One of ordinary skill in the art would fail to see how the address definition can be returned from the first device when the first device is requesting the address definition from the second device. Therefore the claim is vague and indefinite.

10. Claims 21 and 22 recite similar limitations; therefore these claims are rejected under the same rationale.

***Claim Rejections - 35 USC § 103***

11. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

12. Claims 1, 2, 12, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holleran et al. (5,752,059) and Taylor et al. (5,754,306).

13. As per claim 1, Holleran et al. teaches a method of flexibly managing addresses for a communication system (see Holleran et al., col. 3, lines 26-52), comprising the steps of: requesting an address definition from a second device to a first device; returning the address definition containing a plurality of components to the second device from the first device (see Holleran et al., col. 5, lines 40-64); obtaining a corresponding predetermined rule definition for the address definition to generate a new address (see Holleran et al., col. 8, lines 1-20); automatically generating a new address definition including the new address based upon the corresponding predetermined rule definition at the second device (see Holleran et al., col. 8, lines 46-65); and returning the

new address definition including the new address from the second address to the first device (see Holleran et al., col. 9, lines 13-23). But fails to teach generating a new address definition based upon the corresponding conditions at the second device, the new address definition including some components based upon the corresponding predetermined rule definition and the corresponding conditions. However, Taylor et al. teaches automatically generating a new address definition based upon the corresponding predetermined rule definition and corresponding conditions at the second device (see Taylor et al., col. 23, line 52-col. 24, line 18), the new address definition including some components based upon the corresponding predetermined rule definition and the corresponding conditions (see Taylor et al., col. 24, lines 19-40). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Holleran et al. to automatically generating a new address definition based upon the corresponding predetermined rule definition and corresponding conditions at the second device, the new address definition including some components based upon the corresponding predetermined rule definition and the corresponding conditions in order to provide an electronic address book which allows information to be efficiently sent to users of both electronic mail and facsimile transmission (see Taylor et al., col. 3, lines 11-24).

14. As per claim 2, the above-mentioned motivation of claim 1 applies fully in order to combine Holleran et al. and Taylor et al. Taylor et al. and Holleran et al. teach a method of flexibly managing addresses for a communication system, wherein the addresses

include e-mail addresses, document folders, telephone number and fax numbers (see Taylor et al., column 10, lines 28-34).

15. As per claim 12, Holleran et al. teaches a system for flexibly managing addresses for a communication system, comprising: a third device sending a request for an address definition for use with a predetermined operation; a second device connected to said third device for receiving the request for the address definition and sending the request for the address definition (see Holleran et al., col. 3, lines 26-52); and a first device connected to said second device for returning the address definition containing a plurality of components to said second device in response to the address definition request (see Holleran et al., col. 5, lines 40-64), said first device further including an address maintenance unit for maintaining address information (see Holleran et al., col. 4, line 55-col. 5, line 3); wherein said second device obtaining a corresponding predetermined rule definition for the address definition to generate a new address (see Holleran et al., col. 8, lines 1-20) and automatically generating a new address definition including the new address based upon the corresponding predetermined rule definition (see Holleran et al., col. 8, lines 46-65), said second device returning the newly generated address definition including the new address to said third device (see Holleran et al., col. 9, lines 13-23). But fails to teach wherein said second device obtaining predetermined conditions for the address definition to generate a new address, the newly generated address including some components based upon the corresponding predetermined rule definition and the corresponding conditions. However, Taylor et al. teaches wherein said second device obtaining predetermined

conditions for the address definition to generate a new address (see Taylor et al., col. 23, line 52-col. 24, line 18), the newly generated address including some components based upon the corresponding predetermined rule definition and the corresponding conditions (see Taylor et al., col. 24, lines 19-40). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Holleran et al. to wherein said second device obtaining predetermined conditions for the address definition to generate a new address, the newly generated address including some components based upon the corresponding predetermined rule definition and the corresponding conditions in order to provide an electronic address book which allows information to be efficiently sent to users of both electronic mail and facsimile transmission (see Taylor et al., col. 3, lines 11-24).

16. As per claim 22, Holleran et al. teaches a computer readable storage medium storing computer executable instructions for performing the task of flexibly managing addresses for a communication system, the computer executable instructions comprising the steps of: requesting an address definition from a second device to a first device; returning the address definition containing a plurality of components to the second device from the first device (see Holleran et al., col. 5, lines 40-64); obtaining a corresponding predetermined rule definition for the address definition to generate a new address (see Holleran et al., col. 8, lines 1-20); automatically generating a new address definition including the new address based upon the corresponding predetermined rule definition at the second device (see Holleran et al., col. 8, lines 46-65). But fails to teach obtaining a corresponding condition for the address definition to generate a new

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address, the new address including some components based upon the corresponding predetermined rule definition and the corresponding condition; returning the new address definition including the new address from the second device to the first device, the address definition each has a unique ID; determining whether or not an ID already exists; storing the new address if the ID does not exist; and replacing information with the new address if the ID exists. However, Taylor et al. teaches obtaining a corresponding predetermined rule definition and a corresponding condition for the address definition to generate a new address (see Taylor et al., col. 23, line 52-col. 24, line 18), the new address including some components based upon the corresponding predetermined rule definition and the corresponding condition (see Taylor et al., col. 24, lines 19-40); returning the new address definition including the new address from the second device to the first device, the address definition each has a unique ID; determining whether or not an ID already exists; storing the new address if the ID does not exist; and replacing information with the new address if the ID exists (see Taylor et al., col. 29, lines 18-30). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Holleran et al. to obtaining a corresponding predetermined rule definition and a corresponding condition for the address definition to generate a new address, the new address including some components based upon the corresponding predetermined rule definition and the corresponding condition; returning the new address definition including the new address from the second device to the first device, the address definition each has a unique ID; determining whether or not an ID already exists; storing the new address if the ID does not exist; and replacing



information with the new address if the ID exists in order to provide an electronic address book which allows information to be efficiently sent to users of both electronic mail and facsimile transmission (see Taylor et al., col. 3, lines 11-24).

17. Claims 3, 4, 10, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holleran et al. and Taylor et al. as applied to claim 1 above, and further in view of Krishnaswamy et al. (5,999,525).

18. As per claim 3, Holleran et al. and Taylor et al. teach the mentioned limitations of claim 1 above but fail to teach wherein the first device is an existing user account management unit for user account information. However, Krishnaswamy et al. teaches wherein the first device is an existing user account management unit for user account information (see Krishnaswamy et al., column 23, lines 37-47). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Taylor et al. and Holleran et al. to wherein the first device is an existing user account management unit for user account information in order to attach individual systems for billing, provisioning, directory services, messaging services such as voice messaging via a communication link (see Krishnaswamy et al., col. 23, lines 23-36).

19. As per claims 4, 10, and 11, the above-mentioned motivation of claim 3 applies fully in order to combine Holleran et al., Taylor et al., and Krishnaswamy et al.

20. As per claim 4, Holleran et al., Taylor et al., and Krishnaswamy et al. teach an address maintenance unit that corresponds to the existing user account management

unit for managing address information (see Krishnaswamy et al., column 23, lines 37-47).

21. As per claim 10, Holleran et al., Taylor et al., and Krishnaswamy et al. teach wherein said generating the new address definition is performed prior to said requesting the address definition (see Krishnaswamy et al., column 108, lines 21-32).

22. As per claim 11, Holleran et al., Taylor et al., and Krishnaswamy et al. teach wherein the address definition each has a unique ID and further comprises additional steps of determining whether or not an ID already exists; storing the newly generated address if the ID does not exist; and replacing information with the newly generated address if the ID exists (see Krishnaswamy et al., column 102, lines 50-67).

23. Claims 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krishnaswamy et al., Taylor et al., and Holleran et al. as applied to claims 1 and 4 above, and further in view of Ouchi (5,978,836).

24. As per claim 5, Krishnaswamy et al., Taylor et al., and Holleran et al. teach the limitations of claims 1 and 4 as described above but fail to teach wherein the address maintenance unit manages delivery methods by adding a new delivery method. Ouchi however teaches wherein the address maintenance unit manages delivery methods by adding a new delivery method (column 12, lines 46-65). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the above limitation to add wherein the address maintenance unit manages delivery methods by

adding a new delivery method in order to go off route and capture the optimal route of transmission.

25. As per claim 6, Krishnaswamy et al., Taylor et al., and Holleran et al. teach the limitations of claims 1, 4, and 5 as described above but fail to teach wherein the new delivery method is specified in the rule definition. Ouchi however teaches wherein the new delivery method is specified in the rule definition (column 8, lines 13-31). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the above limitation to add wherein the new delivery method is specified in the rule definition in order to insure that the value for the active document is unique.

26. As per claim 7, Ouchi, Holleran et al., Taylor et al., and Krishnaswamy et al. teach the limitations of claims 1, 4, 5, and 6 as described above but Ouchi, Taylor et al., and Holleran et al. fail to teach wherein the rule definition further includes or the address maintenance unit additionally manages an ID value, a Source value, a Condition value, a Name Generation Method value, and a Type Generation Method value.

Krishnaswamy et al., however teaches wherein the rule definition further includes or the address maintenance unit additionally manages an ID value, a Source value, a Condition value, a Name Generation Method value, and a Type Generation Method value (column 99, line 58-column 101, line 16: wherein VNET numbers serve the function of a Condition value, unique ID serves the function of an ID value, IP address serves the function of a Source value, a Name Generation Method value, and a Type Generation Method value). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the above limitation to add wherein the rule

definition further includes or the address maintenance unit additionally manages an ID value, a Source value, a Condition value, a Name Generation Method value, and a Type Generation Method value in order to allow an user to register his/her computer as "on-line" and available to receive calls.

27. As per claim 8, Holleran et al., Taylor et al., and Krishnaswamy et al. teach the limitations of claims 1 and 4 as described above but fail to teach wherein the address maintenance unit manages delivery methods by deleting an existing delivery method. Ouchi however teaches wherein the address maintenance unit manages delivery methods by deleting an existing delivery method (column 6, line 48-column 7, line 7). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the above limitation to add wherein the address maintenance unit manages delivery methods by deleting an existing delivery method in order to permit more than one concurrent use of a workflow route.

28. As per claim 9, Ouchi, Holleran et al., Taylor et al., and Krishnaswamy et al. teach the limitations of claims 1 and 4, as described above but Ouchi, Taylor et al., and Holleran et al. fail to teach wherein the address maintenance unit updates the address information based upon the user account information. Krishnaswamy et al. however teaches wherein the address maintenance unit updates the address information based upon the user account information (column 41, lines 27-35). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the above limitation to add wherein the address maintenance unit updates the address information

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based upon the user account information because cache copies must be refreshed when the version is out of date.

29. Claims 13-21 have similar limitations as to claims 1-12 and 22 above; therefore, they are being rejected under the same rationale.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ranodhi Serrao whose telephone number is (571)272-7967. The examiner can normally be reached on 8:00-4:30pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571)272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/R. N. S./

Examiner, Art Unit 2441

10/20/2008

/William C. Vaughn, Jr./

Supervisory Patent Examiner, Art Unit 2444